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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/289,258 04/09/99 VASEL

E 62862

022242 PM82/0926  
FITCH EVEN TABIN AND FLANNERY  
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CHICAGO IL 60603-3406

EXAMINER

TUDOR, H

ART UNIT

PAPER NUMBER

3641

DATE MAILED:

09/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/289,258	Applicant(s) Vasel et al
Examiner Tudor, H. J	Group Art Unit 3641

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7-26-01
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 193-212 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 193-212 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 15
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other PTO 413

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1. Gibson et al, Woodall et al and Rosa et al have been added in view of applicants' amendments.
2. Applicants petition under 37 CFR 1.48(b), filed on July 26, 2001, has been granted. The inventors Mr. Eric Wenaas and Roger Behrendt have been deleted.
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 193-202 and 205 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the inhibiting substance being a powdered capsaicinoid. The term, capsaicinoid, is broader than oleoresin capsicum.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 203, 206 and 208-212 are rejected under 35

U.S.C. 102(e) as being anticipated by Gibson et al.

Gibson et al disclose a frangible projectile comprising a rigid shell formed of polystyrene, the shell has two cavities which can be filled with a pepper powder, note lines 7-17 of col. 12 and lines 24-34 of col. 13. Fig. 1b, for example, illustrates the cavities of the projectile being substantially filled with the substance to be dispersed upon target impact. Lines 54 and 55 of

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col. 11 also disclose that a powder dye can be contained within the projectile. Lines 18-20 of col. 12 state the cavity 7 includes a coloring agent and a weighting agent 9, for example bismuth or lead.

8. Claims 193-197, 199-202, 204 and 205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al in view of Mangolds et al. Gibson et al is applied as above. However, Gibson et al do not disclose a projectile comprising oleoresin capsicum. Mangolds et al teach oleoresin capsicum to be an art recognized irritant, lines 21-24 of col. 11. Lines 21-24 of col. 11 also state that the material may be in liquid or powder form. To employ powdered oleoresin capsicum in the Gibson et al projectile, as taught by Mangolds et al as being an art recognized equivalent irritant, would have been obvious to one having ordinary skill in the art at the time the invention was made.

9. Claim 198 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al in view of Mangolds et al and Olson. Gibson et al and Mangolds et al are applied as above. However, Gibson et al and Mangolds et al do not disclose a frangible projectile comprising at least one structurally

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weakening feature. Olson teaches using internal score lines in a frangible projectile to enhance fragmentation of the projectile upon impact. To employ internal score lines in the projectile formed by the combination of Gibson et al and Mangolds et al to enhance fragmentation, as taught by Olson, would have been obvious to one having ordinary skill in the art at the time the invention was made.

10. Claim 207 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al in view of Olson. References are applied as above. To employ internal score lines in the Gibson et al projectile to enhance fragmentation, as taught by Olson, would have been obvious to one having ordinary skill in the art at the time the invention was made.

11. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

12. Applicants' Exhibits A-C, the Mills Declaration, The Wagg Declaration, the Campe Declaration, the Beery Declaration, the Behrendt Declaration, The Vasel Declaration and the Heal Declaration, all filed on July 26, 2001, have been carefully considered but are not deemed to be persuasive because Gibson et

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al clearly disclose a frangible projectile comprising a pepper powder. Furthermore, Mangolds et al clearly teach oleoresin capsicum to be a well known irritant. Furthermore, the Mills, Wagg, Campe and Heal declarations attest to the fact hat oleoresin capsicum is an irritant recognized in the art, note paragraph 4 of page 47 of applicants' amendment. It is noted that claims 203 and 206-212 are not commensurate in scope with the invention disclose in the declarations filed on July 26, 2001. For example the Beery Declaration, in paragraph 7, refers to a "red" projectile that contains powdered oleoresin capsicum.

13. Rosa et al and Woodall et al are cited as being of interest in that they disclose frangible payload-dispensing projectiles.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of


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the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold J. Tudor, whose telephone number is (703) 306-4172.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for this Group is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

  
HAROLD J. TUDOR  
PRIMARY EXAMINER